

ESTTA Tracking number: **ESTTA581907**

Filing date: **01/15/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Tough Mudder LLC
Granted to Date of previous extension	01/15/2014
Address	63 Pearl St.#221 Brooklyn, NY 11201 UNITED STATES

Attorney information	Samuel F. Miller Baker, Donelson, Bearman, Caldwell & Berkowitz, PC 211 Commerce Street Suite 800 Nashville, TN 37201 UNITED STATES smiller@bakerdonelson.com, amorris@bakerdonelson.com, sgibbs@bakerdonelson.com Phone:615-726-5594
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Applicant Information

Application No	85911667	Publication date	09/17/2013
Opposition Filing Date	01/15/2014	Opposition Period Ends	01/15/2014
Applicants	Follmer, Christian 371 Inspiration Dr. New Braunfels, TX 78130 USX Mehaffey, Wade 371 Inspiration Dr. New Braunfels, TX 78130 USX		

Goods/Services Affected by Opposition


Class 025. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Apparel for men, women, and children, namely, t-shirts, hats, shorts and tank tops


Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)


Marks Cited by Opposer as Basis for Opposition


U.S. Registration	3810118	Application Date	11/02/2009
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No.			
Registration Date	06/29/2010	Foreign Priority Date	NONE
Word Mark	TOUGH MUDDER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2009/03/01 First Use In Commerce: 2009/03/01 Organizing and conducting sporting events and post-event parties, namely, mud runs, cross-country races, military style obstacle courses, outdoor swimming events and music festivals		

U.S. Registration No.	4131912	Application Date	08/25/2011
Registration Date	04/24/2012	Foreign Priority Date	NONE
Word Mark	TOUGH MUDDER		
Design Mark			
Description of Mark	The mark consists of the silhouette of a man running through fire, to the right of the literal element, "Tough Mudder." The fire spans the width of the entire logo, beginning to the left of the literal element and ending to the right of the running man.		
Goods/Services	Class 041. First use: First Use: 2010/02/01 First Use In Commerce: 2010/02/01 Organizing sporting events, namely, mud runs, cross-country races, military style obstacle courses and outdoor swimming events		


U.S. Registration No.	4131913	Application Date	08/25/2011
Registration Date	04/24/2012	Foreign Priority Date	NONE
Word Mark	WORLD'S TOUGHEST MUDDER		

Design Mark	
Description of Mark	The mark consists of the silhouette of a man triumphantly raising his arms, standing on a pedestal with the literal element "World's Toughest Mudder." The letter "O" in the literal element is a globe. Above the silhouette of the man is a mushroom cloud-like design, in which there is an outline of land on water. There is also a planetary ring around the silhouette of the man, similar to the rings around Saturn.
Goods/Services	Class 041. First use: First Use: 2011/04/01 First Use In Commerce: 2011/04/01 Organizing sporting events, namely, mudruns, cross-country races, military style obstacle courses and outdoor swimmingevents

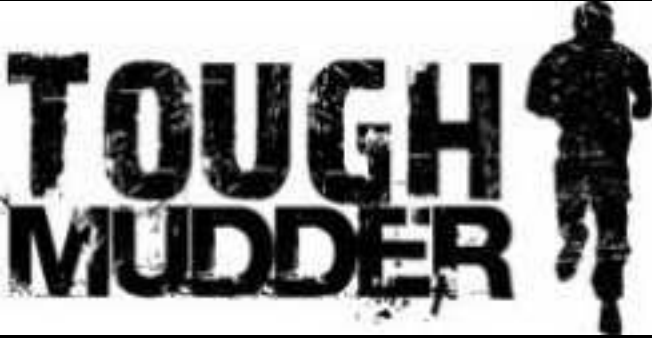
U.S. Application No.	85964910	Application Date	06/20/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	MUDDER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 0 First Use In Commerce: 0 Organizing sporting events, namely, mudruns, cross-country races, military style obstacle courses and outdoor swimmingevents		


U.S. Registration No.	4465111	Application Date	03/28/2013
Registration Date	01/14/2014	Foreign Priority Date	NONE
Word Mark	TOUGH MUDDER		

Design Mark	TOUGH MUDDER
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2010/05/02 First Use In Commerce: 2010/05/02 Bandanas; Beanies; Caps; Hats; Infant and toddler one piece clothing; Shirts; Sweatshirts; T-shirts; Tank tops


U.S. Registration No.	4308918	Application Date	08/01/2012
Registration Date	03/26/2013	Foreign Priority Date	NONE
Word Mark	TOUGH MUDDER		
Design Mark			
Description of Mark	The mark consists of the silhouette of a man running through fire, to the right of the literal element, "Tough Mudder." The fire spans the width of the entire logo, beginning to the left of the literal element and ending to the right of the running man.		
Goods/Services	<p>Class 016. First use: First Use: 2011/01/29 First Use In Commerce: 2011/01/29 Bumper stickers; Posters; Stickers</p> <p>Class 021. First use: First Use: 2011/01/29 First Use In Commerce: 2011/01/29 Aluminum water bottles sold empty; Beermugs; Bottle openers; Bottle squeegees; Drinking glasses, namely, tumblers; Plastic water bottles sold empty; Shot glasses; Sports bottles sold empty</p> <p>Class 025. First use: First Use: 2010/05/02 First Use In Commerce: 2010/05/02 Bandanas; Baseball caps and hats; Beanies; Gym shorts; Hooded sweat shirts; Infant and toddler one piece clothing; Long-sleeved shirts; Sweatpants; T-shirts; Tank tops</p> <p>Class 026. First use: First Use: 2011/10/08 First Use In Commerce: 2011/10/08 Armbands; Belt buckles; Ornamental cloth patches</p>		


U.S. Application No.	85894969	Application Date	04/04/2013
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Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TOUGH MUDDER		
Design Mark			
Description of Mark	The mark consists of the word "TOUGH" above the word "MUDDER" with the image of a man running to the right of the stacked words.		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 Bandanas; Beanies; Caps; Hats; Infant and toddler one piece clothing; Shirts; Sweatshirts; T-shirts; Tank tops Class 041. First use: First Use: 0 First Use In Commerce: 0 Organizing sporting events, namely, mudruns, cross-country races, military style obstacle courses and outdoor swimming events		

U.S. Registration No.	4241513	Application Date	03/21/2012
Registration Date	11/13/2012	Foreign Priority Date	NONE
Word Mark	MUDDER NATION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2011/11/15 First Use In Commerce: 2011/11/15 Entertainment services, namely, providing an entertainment website featuring information and blogs concerning endurance and obstacle challenges, events and training		


U.S. Registration No.	4241512	Application Date	03/21/2012
Registration Date	11/13/2012	Foreign Priority Date	NONE
Word Mark	MUDDER NATION		

Design Mark	
Description of Mark	The mark consists of the stylized stacked wording "MUDDER NATION" to the left of a design of five silhouettes of men who each have one arm raised in the air.
Goods/Services	Class 041. First use: First Use: 2011/11/15 First Use In Commerce: 2011/11/15 Entertainment services, namely, providing an entertainment website featuring information and blogs concerning endurance and obstacle challenges, events and training

U.S. Registration No.	4241510	Application Date	03/21/2012
Registration Date	11/13/2012	Foreign Priority Date	NONE
Word Mark	MUDDER CORPS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2010/11/01 First Use In Commerce: 2010/11/01 Entertainment in the nature of a club formed to allow volunteers to help arrange, organize, operate and conduct endurance and obstacle challenges, events and training		

U.S. Registration No.	4233607	Application Date	03/21/2012
Registration Date	10/30/2012	Foreign Priority Date	NONE
Word Mark	TOUGH MUDDER MOST RESPECT AWARD		

Design Mark	Tough Mudder Most Respect Award
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2010/02/01 First Use In Commerce: 2010/02/01 Entertainment services, namely, providing recognition and incentives by way of celebrations and awards to participants in athletic running and endurance events, whose completion of the event marks an extraordinary feat and milestone in their lives

U.S. Application No.	85696468	Application Date	08/06/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TOUGH MUDDER		
Design Mark			
Description of Mark	The mark consists of The mark consists of The mark consists of the silhouette of a man running through fire, to the right of the literal element, "Tough Mudder." The fire spans the width of the entire logo, beginning to the left of the literal element and ending to the right of the running man.		
Goods/Services	Class 028. First use: First Use: 0 First Use In Commerce: 0 Physical fitness equipment, namely, weights, treadmills, rowing machines, stairstepping machines, resistance machines, stationary cycles, manually-operated exercise equipment for physical fitness purposes, sports fitness restraint straps for running in tandem or pairs, vibrating apparatus used in fitness and exercise programs to stimulate muscles and increase strength and physical performance. exercise equipment and machines accessory for manually-operated exercise equipment, namely, accessory attachment to increase muscle resistance, ankle and wrist weights for exercise, body-training apparatus and devices for physical exercises, namely, elliptical exercise machines, muscle exercising apparatus, namely, manually-operated exercise equipment, namely, accessory attachment to increase muscle resistance, vibrating apparatus used in fitness and exercise programs to stimulate muscles and increase strength and physical performance, weights; portable exercise apparatus, namely, ankle and wrist weights for exercise, ball for exercise, bats		

	<p>for exercise, weights; body toner apparatus, namely, sports training devices to improve toning, conditioning and balance; body building and training apparatus, namely, weights and accessory attachment to increase muscle resistance; weights for physical exercise and body building; exercise bands, namely, stretch bands and resistive exercise bands for physical fitness purposes; skipping ropes. hand exercisers, namely, hand balls stress relief balls for hand exercise; chest expanders; boxing gloves; punching bags; benches for weightlifting, exercise and fitness training; exercise balls; aerobic steps; exercise trampolines; bicycles; stationary exercise bicycles; exercise treadmills; exercise equipment, namely, rowing machines; stair climbing machines for physical exercise; yoga mats</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0</p> <p>On-line retail store services featuring fitness and exercise apparatus and equipment; online retail store services featuring pre-recorded CDs, pre-recorded DVDs, pre-recorded instructional audio and video, bags, towels, clothing, footwear and headgear, clothing, footwear and headgear for sports, athletics fitness and exercise, food and drinks containers, and parts and fittings for the aforesaid goods</p> <p>Class 041. First use: First Use: 2011/08/13 First Use In Commerce: 2011/08/13 (Based on Use in Commerce) Physical fitness conditioning classes; Providing an on-line computer database featuring information regarding exercise and fitness (Based on Intent to Use) Conducting fitness classes; Educational services, namely, providing training of services, classes, seminars, testing and on-line information and news for certification in the field of exercise and fitness; Physical fitness training of individuals and groups; Physical fitness training services; Providing a web site featuring information on exercise and fitness; Providing an interactive website featuring information and links relating to fitness; Providing assistance, personal training and physical fitness consultation to individuals to help them make physical fitness, strength, conditioning, and exercise improvement in their daily living</p>
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Attachments	<p>77862682#TMSN.jpeg(bytes) 85407879#TMSN.jpeg(bytes) 85407888#TMSN.jpeg(bytes) 85964910#TMSN.jpeg(bytes) 85889216#TMSN.jpeg(bytes) 85692214#TMSN.jpeg(bytes) 85894969#TMSN.jpeg(bytes) 85575337#TMSN.jpeg(bytes) 85575330#TMSN.jpeg(bytes) 85575306#TMSN.jpeg(bytes) 85575294#TMSN.jpeg(bytes) 85696468#TMSN.jpeg(bytes) Notice of Opposition.pdf(49397 bytes)</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Samuel F. Miller/
Name	Samuel F. Miller
Date	01/15/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

TOUGH MUDDER, LLC,)	
)	
Opposer,)	
)	
v.)	Opposition No.: _____
)	
CHRISTIAN FOLLMER and WADE MEHAFFEY,)	
)	Serial No. 85911667
)	
Applicants.)	

NOTICE OF OPPOSITION

Tough Mudder, LLC (“Opposer”), a limited liability company organized and existing under the laws of the State of Delaware, with a principal place of business located at 15 MetroTech Center, 7th Floor, Brooklyn, NY 11201, believes that it would be damaged by registration of the mark shown in U.S. Trademark Application Serial No. 85911667 (the “Application”) filed on April 23, 2013, by Christian Follmer and Wade Mehaffey (the “Applicants”) and published for opposition on September 17, 2013. Opposer filed timely requests for extension to oppose, which the Board granted. Accordingly, Opposer hereby opposes registration of said mark pursuant to Section 2(d) of the Lanham Act.

To the best of Opposer’s knowledge, the names and addresses of the current owners of the Application are Christian Follmer, whose address is 371 Inspiration Drive, New Braunfels, Texas 78130, and Wade Mehaffey, whose address also is 371 Inspiration Drive, New Braunfels, Texas 78130.

As grounds for this Opposition, Opposer alleges that:

1. Opposer is one of the leaders – if not the foremost leader – in the outdoor obstacle course challenge industry. Since 2010, Tough Mudder has hosted outdoor obstacle course challenges throughout the U.S. and abroad. Tough Mudder has developed into a preeminent brand through widespread marketing and advertising, and markets, sells, and promotes its services and related goods under the TOUGH MUDDER® mark, MUDDER™ mark, and a family of marks that contain the word “MUDDER” (the “MUDDER family of marks”). Tough Mudder’s challenges foster a unique sense of community among the participants and supporters, and Tough Mudder’s extensive investment of time and resources has led to unprecedented growth and awareness of the Tough Mudder brand, challenges, and ethos. As such, the TOUGH MUDDER® mark, MUDDER™ mark and the MUDDER family of marks are associated not only with high-quality, well-run challenges, but also with an overarching philosophy grounded in teamwork, camaraderie, and fun in the face of challenging obstacles.

2. In addition to common law rights in the TOUGH MUDDER® mark, MUDDER™ mark, and the MUDDER family of marks, Tough Mudder is the owner of U.S. Registrations and applications for several marks containing the term “MUDDER” for organizing and conducting sporting events, namely, mud runs, cross-country races, military-style obstacle courses, and outdoor swimming events, including:

- TOUGH MUDDER, U.S. Reg. No. 3,810,118, with a first use in commerce date of at least as early as March 1, 2009;
- TOUGH MUDDER & Design, U.S. Reg. No. 4,131,912, with a first use in commerce date of at least as early as February 1, 2010; and
- WORLD’S TOUGHEST MUDDER, U.S.Reg. No. 4,131,913, with a first use in commerce date of at least as early as April 1, 2011.
- MUDDER, U.S. Ser. No. 85964910, with a first use in commerce date of at least as early as January 2011.

3. Tough Mudder also is the owner of U.S. Registrations and applications for several marks containing the term “MUDDER” in International Class 25, which is the same class identified in the Application, including:

- TOUGH MUDDER, U.S. Reg. No. 4,465,111, for use in connection with “Bandanas, Beanies, Caps, Hats, Infant and toddler one piece clothing; Shirts, Sweatshirts, T-shirts; Tank Tops,” with a first use in commerce date of at least as early as May 2, 2010.
- TOUGH MUDDER with design, U.S. Reg. No. 4,308,918, for use in connection with “Bandanas, Beanies, Caps, Hats, Infant and toddler one piece clothing; Shirts, Sweatshirts, T-shirts; Tank Tops,” with a first use in commerce date of at least as early as May 2, 2010.
- TOUGH MUDDER with design, U.S. Reg. No. 85894969, for use in connection with “Bandanas, Beanies, Caps, Hats, Infant and toddler one piece clothing; Shirts, Sweatshirts, T-shirts; Tank Tops.”

4. Tough Mudder further is the owner of U.S. Registrations and applications for several marks containing the term “MUDDER”, including

- MUDDER NATION, U.S. Reg. No. 4,241,513, for use in connection with “Entertainment services, namely, providing an entertainment website featuring information and blogs concerning endurance and obstacle challenges, events and training,” with a first use in commerce date of at least as early as November 15, 2011.
- MUDDER NATION with design, U.S. Reg. No. 4,241,512, for use in connection with “Entertainment services, namely, providing an entertainment website featuring information and blogs concerning endurance and obstacle challenges, events and training,” with a first use in commerce date of at least as early as November 15, 2011.
- MUDDER CORPS, U.S. Reg. No. 4,241,510, for use in connection with “Entertainment in the nature of a club formed to allow volunteers to help arrange, organize, operate and conduct endurance and obstacle challenges, events and training,” with a first use in commerce date of at least as early as November 1, 2010.
- TOUGH MUDDER MOST RESPECT AWARD, U.S. Reg. No. 4,233,607, for use in connection with “Entertainment services, namely, providing recognition and incentives by way of celebrations and awards to participants in athletic running and endurance events, whose completion of the event marks an

extraordinary feat and milestone in their lives,” with a first use in commerce date of at least as early as February 1, 2010.

- WORLD’S TOUGHEST MUDDER, U.S. Reg. No. 4,131,913, for use in connection with “Organizing sporting events, namely, mud runs, cross-country races, military style obstacle courses and outdoor swimming events,” with a first use in commerce date of at least as early as April 1, 2011.
- TOUGH MUDDER with design, U.S. Ser. No. 85696468, for use in connection with

Physical fitness equipment, namely, weights, treadmills, rowing machines, stair stepping machines, resistance machines, stationary cycles, manually-operated exercise equipment for physical fitness purposes, sports fitness restraint straps for running in tandem or pairs, vibrating apparatus used in fitness and exercise programs to stimulate muscles and increase strength and physical performance. exercise equipment and machines accessory for manually-operated exercise equipment, namely, accessory attachment to increase muscle resistance, ankle and wrist weights for exercise, body-training apparatus and devices for physical exercises, namely, elliptical exercise machines, muscle exercising apparatus, namely, manually-operated exercise equipment, namely, accessory attachment to increase muscle resistance, vibrating apparatus used in fitness and exercise programs to stimulate muscles and increase strength and physical performance, weights; portable exercise apparatus, namely, ankle and wrist weights for exercise, ball for exercise, bats for exercise, weights; body toner apparatus, namely, sports training devices to improve toning, conditioning and balance; body building and training apparatus, namely, weights and accessory attachment to increase muscle resistance; weights for physical exercise and body building; exercise bands, namely, stretch bands and resistive exercise bands for physical fitness purposes; skipping ropes; hand exercisers, namely, hand balls stress relief balls for hand exercise; chest expanders; boxing gloves; punching bags; benches for weightlifting, exercise and fitness training; exercise balls; aerobic steps; exercise trampolines; bicycles; stationary exercise bicycles; exercise treadmills; exercise equipment, namely, rowing machines; stair climbing machines for physical exercise; yoga mats

On-line retail store services featuring fitness and exercise apparatus and equipment; online retail store services featuring pre-recorded CDs, pre-recorded DVDs, pre-recorded instructional audio and video, bags, towels, clothing, footwear and headgear, clothing, footwear and headgear for sports, athletics fitness and exercise, food and drinks containers, and parts and fittings for the aforesaid goods

Physical fitness conditioning classes; Providing an on-line computer database featuring information regarding exercise and fitness(Based on

Intent to Use) Conducting fitness classes; Educational services, namely, providing training of services, classes, seminars, testing and on-line information and news for certification in the field of exercise and fitness; Physical fitness training of individuals and groups; Physical fitness training services; Providing a web site featuring information on exercise and fitness; Providing an interactive website featuring information and links relating to fitness; Providing assistance, personal training and physical fitness consultation to individuals to help them make physical fitness, strength, conditioning, and exercise improvement in their daily living. (First use in commerce at least as early as August 13, 2011).

5. Opposer has used the TOUGH MUDDER® mark, MUDDER™ mark and the MUDDER family of marks in connection with its services and related goods, and advertising and promotions of its services and related goods throughout the United States, including in Texas where Applicants are located.

6. Opposer's TOUGH MUDDER® mark and the TOUGH family of marks are inherently distinctive and/or have acquired secondary meaning.

7. On April 23, 2013, Applicants filed the Application in which they seek registration of the mark MUDDERZ with the design



(the "MUDDERZ mark") for use in connection with "Apparel for men, women, and children, namely, t-shirts, hats, shorts and tank tops" in International Class 025 (the "Application").

8. If the mark in the Application is permitted to register, the existence of such registration and use of the MUDDERZ mark by the Applicants will likely cause consumer confusion, mistake, or deception with regard to the TOUGH MUDDER® mark, MUDDER™

mark and the MUDDER family of marks or the source and/or origin of any services provided under the TOUGH MUDDER® mark, MUDDER™ mark and the MUDDER family of marks.

9. Upon information and belief, the Application is fraudulent because the Applicants stated that “to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive . . .” Said statement is false because the truth is that the Applicant knew of Opposer and the TOUGH MUDDER® mark, MUDDER™ mark and the MUDDER family of marks. Opposer has used Opposer’s the TOUGH MUDDER® mark since at least as early as 2009, the MUDDER™ mark at least as early as January 2011, and the MUDDER family of marks at least as early as 2010. It cannot be disputed that Opposer is well-recognized as the leader in the parties’ industry and has been named as such by numerous publications. Opposer’s use of the TOUGH MUDDER® mark, MUDDER™ mark and the MUDDER family of marks and Applicant’s use of the MUDDERZ mark are in the same channel of trade and to the same or similar groups of customers.

10. Upon information and belief, for foregoing false and/or misleading statements were made by the Applicants with knowledge that said statements were false and/or misleading. Said false statements were made with the intent to induce authorized agents of the PTO to grant said Application, and, reasonably relying upon the truth of said false and/or misleading statements, the PTO published the marks at issue for opposition.

11. Two copies of this Notice of Opposition and the fee required in 37 C.F.R. § 2.6(a)(17) is enclosed herewith or if electronically filed, filed and paid pursuant to the guidelines by the United States Patent and Trademark Office.

12. This Opposition was served upon the Applicants (who are not currently represented by counsel before the PTO) via FedEx Overnight Delivery sent on January 15, 2014. A certification by Opposer's counsel of this service is located below.

WHEREFORE, Petitioner prays that, pursuant to Section 13 of the Lanham Act, 15 U.S.C. § 1063, U.S. Trademark Application Serial No. 85911667 be denied in its entirety.

Petitioner hereby appoints Samuel F. Miller to prosecute this Opposition and transact all business in the Trademark Trial and Appeal Board in connection therewith. Please send all correspondence to the attention of:

Samuel F. Miller
BAKER, DONELSON, BEARMAN, CALDWELL
& BERKOWITZ, P.C.
211 Commerce Street, Suite 800
Nashville, Tennessee 37201
(615) 726-5594 (office)
(615) 744-5594 (fax)

Respectfully submitted,

Dated: January 15, 2014

/Samuel F. Miller/
Samuel F. Miller
Attorneys for Opposer Tough Mudder, LLC

BAKER, DONELSON, BEARMAN, CALDWELL
& BERKOWITZ, P.C.
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing was mailed, via FedEx Overnight Delivery on this 15th day of January 2014 to the following:

Christian Follmer
371 Inspiration Drive
New Braunfels, Texas 78130

Wade Mehaffey
371 Inspiration Drive
New Braunfels, Texas 78130

/Samuel F. Miller/

Samuel F. Miller